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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/426,956	10/26/1999	JOHN KIHN	KIHNJ40223	2563
21587	7590	06/14/2005	EXAMINER	
ALTMAN & MARTIN 6 BEACON ST, STE 600 BOSTON, MA 02108			GORT, ELAINE L	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/426,956

Applicant(s)

KIHN, JOHN

Examiner

Elaine Gort

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 14-17, 19, 20 is/are pending in the application.  
4a) Of the above claim(s) 1-7, 15-17, 19 and 20 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 10/2/03; 8/23/03; 10/26/99 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

This application is in condition for allowance except for the following formal matters:

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term CUSIP in Claim 14 line 7 is unclear, it must be followed with the definition of the abbreviation in parentheses.

Claim 14 line 7 defines the portfolio data to include data level fields that include a portfolio field and a date field. Portfolio data is also defined to include security level fields. It is unclear how these values are summed as claimed in line 4. For example, it is unclear how dates are summed. This should be clarified or amended out of the claims.

Claim 14 recites the limitation "the securities" in 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the number" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "that portfolio/fund" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the portfolio/fund market value" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the number of portfolios/funds in the benchmark" in line 22. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the equities" in line 24. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the reciprocal" in line 25. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the weight" in line 25. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the scaling factor" in line 29. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the sum" in line 30. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the adjusted scaling factor for the  $j$ th" in line 35. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the adjusted market value of security  $i$ " in line 43. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the weight of the  $i$ th security" in line 49. There is insufficient antecedent basis for this limitation in the claim.

It is unclear in line 51 what is being claimed in regard to "(by construction)".

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (571)272-6788. The fax phone number for the organization where this application or processing is assigned is (703)872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Elaine Gort

Examiner - 3627

June 9, 2005